

No. 15884

IN THE

# United States Court of Appeals

FOR THE NINTH CIRCUIT

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ROHR AIRCRAFT CORPORATION and THE FRANKLIN C.  
WOLFE COMPANY, INC.,

*Appellants,*

*vs.*

RUBBER TECK, INC., RUBBER TECK SALES AND SERVICE CO.,  
PAUL A. KARRES, OTTO R. GRASS and JOE P. KERLEY,

*Appellees.*

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PAUL A. KARRES, OTTO R. GRASS and JOE P. KERLEY,

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WOLFE COMPANY, INC.,

*Appellees.*

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Reply Brief of Rohr Aircraft Corporation and the  
Franklin C. Wolfe Company, Inc., Appellants.

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Defendants' brief raises a few new points not covered  
in Plaintiffs' Opening Brief which will be considered  
herein.

## Patent Issues.

Defendants' premise is that any mechanic could have  
thought of rounding the corners off of the Killner device,  
and that Defendants are therefore being deprived of a  
"fair use" of the Killner disclosure. At the same time it  
is admitted that Defendants may have copied each and  
every dimension on Plaintiffs' data sheet for 26 different

sizes of Plaintiffs' devices (Deft. Br. p. 38). Not only may have, *but did*, we might add, as the positive evidence shows.

When Defendants decided to go into direct competition with their employers they did so with a design and a trade name which were slightly different from those of the Plaintiffs, yet close enough to reap all of the advantages of Plaintiffs' device and Plaintiffs' good will. As said by Judge Learned Hand in speaking of such differences, "Minor differences are supposed to help over hard places."

There is no evidence to show that the Defendants had even heard of the Killner patent until after they had commenced making the accused device. On the other hand, Defendants had directly known for years of the Plaintiffs' patent, the success of the patented device, and all of its dimensions. We submit that this "fair use" proposition of which the Defendants speak should be fully considered in the determination of this case, particularly with respect to whose invention the Defendants are using, Plaintiffs' or Killner's.

Cases are cited by Defendants to show that even a "dumb" mechanic might think of rounding off corners on an object. As applied to the present case however, these decisions, based on facts entirely different than the present facts, are not in point.

The proposition before this court is not that of rounding off the edges of a tray to give *protection against* injury of workmen as in the case of *Oxford Varnish Corporation v. General Motors Corporation*, 23 Fed. Supp. 562, 38 U. S. P. Q. 42. Neither is it the proposition of rounding off the corners of a box to *make it look better* as in the design patent case of *Acton Manufacturing Co., Inc. v. Louisville Tin & Stove Co.*, 116 Fed. Supp. 796, 99 U. S. P. Q.

410. The present invention is not concerned with rounding anything off, but rather is concerned with the problem of sealing around the shank of a fastener. The obvious approach to this problem was to use a rectangular sealing member, as was done by Killner in 1941 [R. 956] or by Hart in 1867 [R. 927]. It was *not* obvious to the many skilled workers who preceded Gross and Cornwall that a sealing device having the relative geometry of the patented device would perform in a new and advantageous manner *to achieve a better fastener seal.*

If one were to follow the teachings of the prior art patents (as the defendants certainly did not do) he could search through every word in every patent without finding the slightest suggestion that a superior seal could be achieved by providing a sealing ring of substantially round configuration to fit snugly on the shank of the bolt in combination with an outer retaining washer centered on the bolt by the ring. Defendants extended speculations as to whether or not the Killner seal *might* be self-centering and otherwise satisfactory most certainly do not supply this deficiency of the art.

The fact is that no one did appreciate the significance of the present invention until the Plaintiffs put it to use. This is the real test to determine what can be gleaned from the prior art. As was said by the Supreme Court in *C. & A. Potts & Co. v. Frank F. Creager, et al.*, 155 U. S. 597, 39 L. Ed. 275:

“\* \* \* The apparent simplicity of a new device often leads an inexperienced person to think that it would have occurred to anyone familiar with the subject; but the decisive answer is that with dozens and perhaps hundreds of others laboring in the same field, it has never occurred to anyone before. The prac-



ticed eye of an ordinary mechanic may be safely trusted to see what ought to be apparent to everyone.”

Defendants in their brief at page 16 speak of demonstrations involving a Killner type of sealing device. These demonstrations are purported to show by “concrete evidence” that the Killner sealing device works just like the accused device and the patented device. We should like to point out that the evidentiary value of these demonstrations to prove anything, is negligible since there was no foundation at all for their reliability. Otto Grass conducting these alleged demonstrations testified as follows [R. 710]:

“Mr. Fulwider: What I want to know is what his testimony is. Either it has extruded or it has not extruded. A. That I don’t know, unless I have a magnifying glass to see.

[R. 712]:

Mr. Fulwider: May I inquire if that cross-section before it is compressed is truly square? I think it was once called square and once rectangular. Is it a square?

Mr. Miller: I will ask the witness.

The Witness: I wouldn’t know whether it was square any more than I would know that the O ring was round in the Lock-O-Seal.

[R. 718]:

Q. (By Mr. Lee): Referring to Exhibit AI, Mr. Grass, this is a ring with a rectangular section?  
A. Yes it is.

Q. Referring to that Exhibit AI, Mr. Grass, did you ever test it to find out if it would seal under pressure? A. I did not.

Q. Is the device AI as good as the Duo-Seal? A. I haven’t made any comparison test.”



If the Defendants had really wished to put on any tests involving the Killner sealing device there were perfectly good procedures available to them to properly conduct such tests. In view of the clearcut statements of the owners of the Killner patent quoted in Plaintiffs' Opening Brief as to the deficiencies of the Killner device, we believe it will be clear to this court why the Defendants did not wish to make any proper demonstrations.

Defendants state baldly that the Seligman patent [R. 945] is an anticipation and then proceed in a lengthy discourse to explain how they arrive at this point of view. We would again direct the court's attention to Figure 1 of the Seligman patent drawings in order to obtain a good idea of what the device really looks like. If anything further need be said, it should be noted that this resilient spacer has upper and lower tabs with obvious bolt holes therein to receive securing fasteners. Thus the device *is fixed in position and held against rotation by external means*. The problem of obtaining uniform sealing around the periphery of a small bolt by a self-contained sealing device which *can rotate and take an eccentric position* is the problem which Killner failed to solve, and the patented device does solve. This problem is not even presented with the Seligman type of device, and it would be impossible for the spacers of Seligman to adjust their positions relative to the sections of the built-up heat exchanger.

At page 36 of their brief Defendants discuss at length the many advantages that the accused device supposedly has over the Lock-O-Seal. Then it is stated at page 39 that Plaintiffs' one-piece Lock-O-Seal has the same objections which were overcome in the accused device.

We would remind the Defendants of their own testimony [R. 719]:

“Q. (By Mr. Lee): Have you ever examined the one-piece Lock-O-Seal or Stat-O-Seal, Mr. Grass?

A. I have looked at it, yes.

Q. I show you Exhibit No. 82, Mr. Grass. Is that the kind of a Stat-O-Seal or one-piece Lock-O-Seal that you examined? A. That is a Stat-O-Seal similar to the one I have seen before.

Q. I believe you said there were certain advantages in the Duo-Seal over the two-piece Lock-O-Seal, is that correct? A. That is correct.

Q. Would those same advantages be found in this Stat-O-Seal? A. Yes, I imagine the same; providing their mold is made so that it will allow for the different thicknesses of the washer, it would be the same.”

Also of the prior testimony of Smith, the Wolfe Co. General Manager [R. 616]:

“Q. Do you recall whether you discussed with Mr. Kerley and Grass at the conference any drawings or showed them any drawings concerning the Lock-O-Seals, the one-piece Lock-O-Seals and the molds or the molds that could be used with those one-piece seals? A. Yes, we went through several sizes of the drawings of the metal insert and the finished product and the various methods of making the molds so that they would compensate for the thickness variation of the retainers; although they had seen the product, they didn't know what the exact dimensions and tolerances were and what production difficulties they might encounter.”

Lastly we would like to point out that no matter how hard the Defendants try to confuse the issue, the undis-

puted evidence is that Plaintiffs were marketing the one-piece Lock-O-Seals well over a year before the Defendants started (see the evidence discussed at pp. 44 and 45 of Pltf. Op. Br.).

### The Development of the One-Piece Seal.

As we pointed out in the Opening Brief the trial court apparently never resolved the conflict of evidence concerning the development of the one-piece seal. Defendants take the position that this conflict was resolved and various testimony is quoted in their brief, all to the end that they had disclosed such a device to Smith the general manager of the Plaintiff Wolfe. We would like to point out briefly certain positively incredible aspects of this testimony.

Elam testified that the disclosure took place in Smith's office and that he, Kerley and Smith were the parties present [R. 664]. Grass testified that the disclosure took place at a conversation between himself and Smith alone [R. 944]. Karres testified that the disclosure took place at the Rubber Teck plant and that Karres, Smith and Grass were the parties present [R. 507]. We submit that oral testimony of this character is highly unreliable particularly when the Defendants do not bring forth any drawings, work records, samples, memoranda, or any scrap of documentary evidence to show that they ever made a one-piece seal prior to November of 1953.

On the other hand, the testimony of Smith concerning the development of the one-piece seal in 1952 [R. 589-598], is fully supported by the drawings Exhibits 60, 61, 62, 64, 65, 66, 67, and 68 [R. 883-891] and the sales records Exhibits 101, 102, 103, 104 and 105 [R. 903-912].

## Record on Appeal.

We do not propose to waste the time of this court on this point. However, Defendants in their brief devote a lengthy section (pp. 49-55) to this topic and it requires a short answer.

It would appear to be the intention of Defendants to convey to this court the impression that Defendants paid for printing those portions of the record itemized at pages 50 and 51 of their brief. This is simply not true. By a letter to the Clerk of this court of March 28, 1958, he was directed to bill Plaintiffs-Appellants for the costs of printing most of the testimony which is detailed in Defendants' brief. A copy of this letter was sent to Defendants' counsel. Subsequently Plaintiffs' counsel received an upwardly revised estimate which Plaintiffs paid.

## Conclusion.

Defendants seek throughout their brief to create equities for themselves which do not exist. This is a case of deliberate willful infringement of a meritorious patent, accompanied by a course of conduct resulting in unjust enrichment of Defendants, and constituting unfair competition with Plaintiffs. We believe nothing more need be said.

Respectfully submitted,

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